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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,342	10/22/2003	Kenji Ogasawara	16869Q-092900US	8540
20350 7590 07/24/2007 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER OLSON, JASON C	
			ART UNIT 2627	PAPER NUMBER
			MAIL DATE 07/24/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/692,342	OGASAWARA ET AL.	
	Examiner	Art Unit	
	Jason C. Olson	2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12, 13, 15-18 and 23-25 is/are allowed.
- 6) ☒ Claim(s) 1-11 and 19-22 is/are rejected.
- 7) ☒ Claim(s) 26-28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claim 19 is objected to because of the following reasons: the claim ends in a semi-colon, and the examiner is unsure if this is a typo or if there is missing claim language. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 21, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Oh et al. (U.S. Pat. 6,189,051), hereafter, "Oh".

Regarding claim 1, Oh teaches recognizing means used for recognizing that an optimization/inspection process to be performed on the hard disk device has not yet been completed (see col. 3, ln. 56-col. 4, ln. 9, col. 4, ln. 62-col. 5, ln. 1 and figures 2 and 5; client computer 550 creates a hard disk master 200 (a hard disk drive) which comprises a downloading portion 560, which downloads needed programs in such that it recognizes that the hard drive is not complete, so it must download the needed programs to be complete); growth-program receiving means (see figures 2 and 5, disk drive master 200 of the client computer 550 comprises a downloading portion 560, which is a receiving means), based on the recognition of the

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recognizing means, for receiving from a parent hard disk drive (see col. 3, ln. 56-65, col. 4, ln. 34-38 and figures 1 and 5, the servo computer 500 contains a hard disk 110 data base 510, which is a parent hard disk drive) connected to the hard disk drive (see figures 2 and 5, the hard disk master 200 of computer 550) a growth program necessary for performing the optimization/inspection process on the hard disk drive itself (see col. 4, ln. 61-col. 5, ln. 1; the downloading portion 560 receives the programs from data base 510); and execution means, based on the growth program received by the growth-program receiving means, for executing the optimization/inspection process on the hard disk drive itself (see col. 5, ln. 1-6 and figure 5, hard disk master generating portion 570 installs or executes).

Regarding claim 2, Oh teaches command transmitting means, based on the recognition of the recognizing means, for transmitting a command requesting the growth program to the parent hard disk drive (see col. 3, ln. 66-col. 4, ln. 17 and col. 4, ln. 62-65; the hard disk master 200 of client computer 550 is logged into the data base of the servo computer 500 to download programs, which constitutes transmitting a command request).

Regarding claim 3, Oh teaches storing means for storing in a memory the growth program executed by the execution means (see col. 4, ln. 1-3; the programs are stored into the hard disk drive, so it is inherent that there must be a memory); wherein, if the hard disk drive is thereafter connected to another hard disk drive in which the optimization/inspection process has not yet been completed, the growth program stored in the storing means is supplied to the another hard disk drive (see col. 4, ln. 3-8 and figure 2; the programs are supplied from drive 200 to new drives 220).

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Regarding claim 4, Oh teaches circuitry on the parent hard disk drive takes controls a predetermined part of the optimization/inspection process to be executed by the execution means (see col. 5, ln. 16-24; the data base comprises a setup file generating portion, which dictates the order in which the programs are installed or executed).

Regarding claims 5-8: Claims 5-8 have limitations similar to those treated in the above rejection(s), and are met by the references as discussed above. Claims 5-8 however also recites the following limitations as taught by Oh: a ROM and a MPU (see col. 3, ln. 56-col. 4, ln. 12 and figures 1, 2, and 5; the hard disk master 200 of client computer 550 comprises a ROM 102 and a CPU or MPU 100).

Regarding claims 21 and 22: claim 21 and 22 are drawn to the functions of using the corresponding apparatus claimed in claims 1-4. Therefore claims 21 and 22 correspond to apparatus claims 1-4 and are rejected for the same reasons of anticipation as used above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-11, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oh in view of Yatsu (U.S. Pat. 6,738,215).

Regarding claims 9-11, Oh teaches connection means adapted to be connected to an unfinished hard disk drive (see figures 2 and 5, the data base 510 hard disk drive of computer

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500 is connected to unfinished hard disk master 200 of computer 550); storing means for storing a program (see col. 4, ln. 36-38 and figure 5; data base 510 is a storage means); and supplying means for supplying the unfinished hard disk drive with the program stored in the storing means (see col. 4, ln. 62-col. 5, ln. 1; different programs and files are supplied from data base 510 to hard disk master 200 of unfinished computer 550); receiving means for receiving a request command for the program from the unfinished hard disk drive; wherein the supplying means supplies the program on the basis of the request command received by the receiving means (see col. 4, ln. 61-5, ln. 1; data base 510 of computer 500 receives a request when computer 550 logs in and downloads programs, which are then supplied by data base 510 to hard disk master of computer 550); and the program includes a function of executing optimization/inspection processing (see col. 5, ln. 1-6; setting the environment is an optimization/inspection process), and the hard disk drive further includes execution means for executing part of the optimization/inspection processing on the unfinished hard disk drive (see col. 5, ln. 34-39; computer executes downloaded programs).

Oh fails to disclose unfinished servo information in a drive and storing a program by which the unfinished hard disk drive writes servo information to at least one disk of the unfinished hard disk drive and by which the hard disk drive writes servo information to at least one disk of the hard disk drive. However, Yatsu is relied upon to teach an unfinished drive (see col. 7, ln. 39-41; reference patterns are recorded on the disk but the disk is unfinished), storing a program for self servo writing (see col. 7, ln. 27-29; the self-servo writing operation writes servo information to the disks of the drive in which the program is stored) and executing the program to self-servo write (see col. 7, ln. 49-56). It would have been obvious to one of ordinary skill in

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the art at the time the invention was made to improve upon programs that are transferred to an unfinished drive of Oh by applying the teaching of transferring a self-servo writing program to an unfinished drive as taught by Yatsu for the purpose of increasing accuracy of the write positions and timing of servo patterns and to reduce disk manufacturing costs as suggested by Yatsu in column 3, line 58-63.

Regarding claims 19 and 20: method claims 19 and 20 are drawn to the method of using the corresponding apparatus claimed in claims 9-11. Therefore method claims 19 and 20 correspond to apparatus claims 9-11 and are rejected for the same reasons of obviousness as used above. The combination of Oh and Yatsu teaches a connection between the data base 510, which comprises elements 520, 530, and 540 and the hard disk master 200, which comprises elements 560 and 570, via a network (see figures 4 and 5 of Oh). Oh fails to teach that the particular connection between the data base and hard disk master is a direct connection. However, it would have been obvious to an artisan in the art to connect the data base and the hard disk master directly, the motivation being that information is transmitted faster, safer, and with greater reliability between two hard disk drives via a direct connection, than via a network connection.

Allowable Subject Matter

Claims 12, 13, 15-18 and 23-25 are allowable over the prior art of record. Claim 12 teaches completing an optimization processing of the first hard drive with information used for optimization; supplying the information for optimization, which is included in the first hard disk drive, from the first hard disk drive to the second hard disk drive; and controlling, according to the supplied information used for optimization, the second hard disk drive to execute processes

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so as to mature into an optimized hard disk drive. Claim 23 teaches receiving, at the hard disk drive from another hard disk drive in which a optimization/inspection process has only been partially completed, a request for a growth program by which the another hard disk drive executes the optimization/inspection process by itself; reading out the growth program stored in a memory of the hard disk drive; and supplying the another hard disk drive with the growth program read out. Claim 25 teaches writing servo information to a disk on the hard disk drive by use of information exported from another hard disk drive; executing an inspection process on the hard disk drive by use of information exported from another hard disk drive and exporting information to a third hard disk drive for the third hard disk drive to execute an inspection process.

Claims 26-28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 05/08/07 have been fully considered but they are not persuasive.

Regarding claims 1-4, the applicant states that, "because Oh differentiates between computers 500 and 550 and hard drive 110 that is within the computer system, computers 500 and 550 are not hard drives". The applicant further states that Elements 560 and 570 are shown to be separate from a hard disk drive. Accordingly, Oh does not teach or suggest a hard drive with recognizing means, growth-program receiving means, and execution means." The examiner

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disagrees. The server computer 500 and the client computer 550 each contain a hard disk drive because they are computers, see column 3, lines 56-65 of Oh. Database 510 of servo computer 500 is a parent hard disk drive because it stores and manages the programs and drivers to be stored in the hard disk, see column 4, line 34-40 of Oh. Hard disk master 200 of client computer 550 is a hard disk drive to which programs are stored; see column 3, lines 66-column 4, lines 17 and figure 4. The hard disk master comprises a recognizing means (downloading portion 560), growth-program receiving means (downloading portion 560) and an execution means (hard disk master generating portion 570), which are all contained in the client computer 550. The elements 560 and 570 are shown as separate elements but they are still comprised by the hard disk master as evidenced by Oh in column 4, line 61 through column 5, line 6.

Regarding claims 5-8, the applicant presents the same arguments as claim 1 and the examiner disagrees with the applicant for the reasons given above.

Regarding claims 21-22, the applicant argues that, Oh does not teach or suggest a processor in a hard disk drive that recognizes that an optimization/inspection process to be performed in the hard disk drive has not yet been completed and requests another hard disk drive to supply a growth program that is required to perform the optimization/inspection process by the hard disk drive". In response to applicant's arguments, the recitation of a processor has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152,

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88 USPQ 478, 481 (CCPA 1951). Furthermore, the functional limitations of the claim are similar to those in are drawn to the functions of using the corresponding apparatus claimed in claims 1-4. Therefore claims 21-24 correspond to apparatus claims 1-4 and are rejected for the same reasons of anticipation as used above.

Regarding claims 9-11, the applicant recites similar arguments in claim 1 and the examiner disagrees for the same reasons given above. Furthermore, the applicant states that, "Also, the disks of database 510 cannot store a program for writing servo information to those disks". The applicant gives no rational to this argument, or factual evidence that suggests that the database 510 cannot store a program for writing servo information to those disks. Therefore, the examiner will consider this argument a general allegation and will not respond.

Regarding claims 19-20, the applicant argues that neither Oh nor Yatsu teach a direct connection between the first hard disk drive and the second hard disk drive because the connection between the servo computer system and the client computer system is over a network. Furthermore, "there are multiple objects between the database and the disk drive on the client computer". The examiner disagrees because it would have been obvious to an artisan in the art that the data base 510, which comprises elements 520, 530, and 540 can be connected directly to the hard disk master 200, which comprises elements 560 and 570 via a cable for the reasons set forth above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason C. Olson whose telephone number is (571)272-7560. The examiner can normally be reached on Monday thru Thursday 7:30-5:30; alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (571)272-7589. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/William R. Korzuch/

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